

### **REMARKS**

The Non-Final Office Action dated November 12, 2008 has been received and reviewed. Prior to the present communication, claim 1 was pending in the subject application. All claims stand rejected. Claim 1 has been amended herein and claims 2-7 have been added. Care has been exercised to introduce no new matter. Applicant respectfully requests reconsideration of the present Application in view of the above amendments and the following remarks.

#### **Rejections based on 35 U.S.C. § 101**

The United States Supreme Court has recognized that the expansive language of 35 U.S.C. § 101 includes as statutory subject matter "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09 (1980). The USPTO has adopted the Supreme Court's interpretation and has stated that, in practice, the complete definition of the scope of 35 U.S.C. § 101 "is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent." MPEP 2106(IV)(A).

Claim 1 has been rejected under 35 U.S.C. § 101 because the invention as claimed was ostensibly directed to non-statutory subject matter. In particular, claim 1 was said to "not require any structure or apparatus to realize the recited functionality." *See Office Action dated 11/12/2008*, page 2. Independent claim 1 has been amended herein to recite *computer-storage media having computer-useable instructions embodied thereon* for effecting a controlled, recurring assessment of a care episode and service utilization patterns associated with a locale. Support for the amendment may be found in the As-Filed Specification at the Appendix. In general, an amendment to the claimed subject matter is not "new matter" within meaning of 35

U.S.C. § 132 or Rule 118 of Patent Office Rules of Practice, unless it discloses an invention, process, or apparatus not theretofore described. Further, if later-submitted material simply clarifies or completes prior disclosure it cannot be treated as "new matter."<sup>1</sup> Accordingly, because computer-storage media are implicitly disclosed by way of Applicant's submission of source code in the As-Filed Specification at the Appendix, the newly recited claim amendment does not constitute new matter. Further, the Federal Circuit has stated that computer programs "embodied in a tangible medium" are patentable subject matter. *See In re Beauregard*, 35 USPQ2d 1383, 1384 (Fed. Cir. 1995). As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 101 rejection of claim 1. Claims 2-7 depend, either directly or indirectly, from independent claim 1 and, thus, are believed to be directed to statutory subject matter.

#### **Rejections based on 35 U.S.C. § 103(a)**

##### **A. Applicable Authority**

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." In *Graham v. John Deere*, the Supreme Court counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1 (1966).

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<sup>1</sup> *Triax Co. v Hartman Metal Fabricators, Inc.*, 479 F2d 951 (1973, CA2 NY); cert. denied, 94 S. Ct. 843 (1973).

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02 (I) (emphasis in original) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

“The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness . . . . To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then determine whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. *Id* (emphasis added). Knowledge of applicant's disclosure must be put aside in reaching this determination . . . . [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious.” MPEP § 2142 citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) (emphasis added), which notes that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

Moreover, the Federal Circuit has stated that “rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP § 2142 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). See also *KSR*, 127 S. Ct. at 1741 (quoting Federal Circuit statement with approval).

B. Rejection of claim 1

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over “MSU Rurality Index: Development and Evaluation,” Research in Nursing & Health, 1995 (hereinafter “the Weinert reference”) in view of “Geographic Variations in Utilization Rates in Veterans Affairs Hospital and Clinics” NEJM January 1999 (hereinafter “the Ashton reference”) and “Access to Physicians in Underserved Communities in Canada: Something Old, Something New” (hereinafter “the Chan reference”). Applicant submits that the cited references fail to teach or suggest every element of claim 1, as amended herein. As such, Applicant respectfully traverses this rejection.

Independent claim 1, as amended herein, is directed to computer-storage media having computer-executable instructions embodied thereon that perform a method for effecting a controlled, recurring assessment of a care episode and service utilization patterns associated with a locale. In particular, amended independent claim 1 recites, in part, standardizing the provisional index using the equation:

$$d\_episode(i) = \frac{I_i - mean(I)}{std(I)}.$$

In contrast, the Weinert reference does not teach or suggest the above equation. The Weinert reference discloses a study for a measure of rurality that involves statistical analysis of two variables: county population and distance (for a family) to emergency care. See, *Weinert*

reference at p. 455, Col. 2, ¶ 2. The *Weinert* reference discloses a statistical analysis that provides an indication of rurality. *See generally Weinert reference*. However, the *Weinert* reference does not disclose assessing the quality of health services in a locale by standardizing the provisional index using the equation  $d\_episode(i) = \frac{I_i - mean(I)}{std(I)}$ . Rather, the *Weinert* reference simply uses the distance to emergency care to ascertain relative rurality. The *Weinert* reference does not teach or suggest that the finer urban/rural classifications provided by the statistical method may be useful in comparing health care variables. *See Weinert reference* at p. 454, Col. 2, ¶ 3, p. 463, Col. 2, ¶ 6.

The addition of the *Ashton* and *Chan* references fails to overcome the deficiency of the *Weinert* reference as they, too, fail to teach or suggest standardizing the provisional index using the equation  $d\_episode(i) = \frac{I_i - mean(I)}{std(I)}$ . The *Ashton* reference discloses a study of geographic variation in the Department of Veterans Affairs hospitals analyzing the utilization variation among the 22 networks within the Department. *See generally Ashton reference*. The Department of Veterans Affairs study of the *Ashton* reference, like the *Weinert* reference, fails to teach or suggest using clinical indicators to assess the health services of a locale using, in part, the equation  $d\_episode(i) = \frac{I_i - mean(I)}{std(I)}$ . Further, the *Chan* reference discloses using indicators to identify areas with a shortage of health care providers. The *Chan* reference, however, fails to teach or suggest standardizing the provisional index using the equation  $d\_episode(i) = \frac{I_i - mean(I)}{std(I)}$ . Accordingly, it is respectfully submitted that the *Weinert*, *Chan*, and *Ashton* references, either alone or in combination, fail to teach or suggest each element of

independent claim 1, as amended herein. As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection. Claims 2-7 depend, either directly or indirectly from claim 1 and, as such, are believed to be in condition for allowance.

**New Claims**

Claims 2-7 have been added herein. Applicants believes that each of claims 2-7 is in condition for allowance and such favorable action is respectfully requested for at least the above-noted reasons.

### CONCLUSION

For at least the reasons stated above, claims 1-8 are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [ddevers@shb.com](mailto:ddevers@shb.com) (such communication via email is herein expressly granted) – to resolve the same.

Submitted herewith is a request for a three-month extension of time, along with the appropriate fee. It is believed that no additional fee is due, however, if this belief is in error, the Commissioner is hereby authorized to charge any amount required, or credit any overpayment, to Deposit Account No. 19-2112, referencing attorney docket number CRNI.103792.

Respectfully submitted,

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